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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,531	04/20/2004	Patrick A. Gane	252169US0CONT	2962

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EXAMINER

HALPERN, MARK

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application, or proceeding.

Office Action Summary

Application No.

10/827,531

Applicant(s)

GANE ET AL.

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-42, 44, 45, 48-51, 55-61, 66-71, 75-80 and 83-88 is/are pending in the application.
- 4a) Of the above claim(s) 40, 41, 66-70 and 80 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 85-88 is/are allowed.
- 6) ☒ Claim(s) 38, 39, 42, 44, 45, 48-51, 55-61, 71, 75-79, 83 and 84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 7/24/2006.

Claim 38 is amended, claims 46-47, 62-65, 81-82 are cancelled, and new claims 83-88 are offered for consideration. Claims 40-41, 66-70, 80, remain withdrawn.

Claims 38-39, 42, 44-45, 48-51, 55-61, 71, 75-79, 83-88 are under consideration.

Claim Objections

- 2) The withdrawn claims 40-41, 66-70, 80, should recite claims status identifier as - (Withdrawn) - .
- 3) Remarks of 7/24/2006, on page 12, line 2, indicate that claim 58 is cancelled, however the claim 58 is listed as a pending claim. Clarification is required.
- 4) Remarks of 7/24/2006, on page 12, line 6, refer to claim 1, however claim 1 is cancelled. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims 38-39, 42, 44-45, 48-51, 55-61, 71, 75-79, 83-84, are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Naydowski (5,605,568). Naydowski discloses a coating pigment slurry composite that includes the following ingredients: calcium carbonate, talc, and a binder. Calcium carbonate represents component that has a hydrophilic site. Talc represents component that has an organophilic site. The binder is a polymer or copolymer of acrylic, methacrylic, itaconic, crotonic or fumaric acids (col. 5, lines 1-20, col. 7, lines 30-31). The slurry includes water (col. 3, line 37). The composite components are bound by the binder. Naydowski uses a novel type of binder (col. 2, lines 10-12). It is inherent that the components of Naydowski are co-structured or co-adsorbed. The present specification defines as forming a structure comparable to a bond or an adhesion between the components. Fumaric acid is an organic compound. The percentage of calcium carbonate is 24 to 64 % by weight; the percentage of talc is 5 to 48 % by weight; the percentage of binder is 1.4 % (col. 3, lines 35-46). In regard to the composite compound of mineral or organic fillers or pigments being macroscopically homogeneous, the specification does not define what is macroscopically homogeneous. It is inherent that the composite compound is

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macroscopically homogeneous, because the composite has a uniform appearance to the naked eye, that is, without the use of a microscope. The composition is used for coating paper color especially for gravure printing (Abstract, and col. 7, lines 15-17).

In the event any differences can be shown for the product of the product-by-process claims 38-39, 42, 44-45, 48-51, 55-61, 71, 75-79, 83-84, as opposed to the product taught by the reference Naydowski, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

Allowable Subject Matter

6) Claims 85-88 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indicating allowable subject matter is that the cited prior art does not show: a paper coating color which includes a composite compound of mineral or organic fillers or pigments of whiteness claimed (claim 85); a paper coating color which includes a composite of mineral or organic fillers or pigments of brightness claimed (claim 86); a paper coating color which includes a composite of mineral or organic fillers or pigments of a curve representative of the tack force claimed (claim 87); a paper coating color which includes a composite of mineral or organic fillers or pigments of print density claimed (claim 88).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7) Claims 38-42, 44, 45, 48-51, 55-61, 66-71, 75-80, 83-84, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59, of U.S. Patent No. 6,666,953. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention discloses a composite compound of mineral or organic fillers or pigments blended with binding agent as does the patent.

Response to Amendment

8) Claims 38-39, 42, 44-51, 55-65, 71, 75-79, 81-82, rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of amended and cancelled claims.

9) Claims 38-39, 42, 44-50, 55-56, 58-59, 71, 75-76, 81, 82, rejection under 35 U.S.C. 103(a) as being unpatentable over Naydowski (5,605,568), is withdrawn in view of amended and cancelled claims.

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10) Claims 51, 60, 77-79, rejection under 35 U.S.C. 103(a) as being unpatentable over Naydowski in view of Andersen (5,662,731), is withdrawn in view of amended and cancelled claims.

11) Claims 61 is rejection under 35 U.S.C. 103(a) as being unpatentable over Naydowski in view of Arrington-Webb (5,584,924), is withdrawn in view of amended and cancelled claims.

12) Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

13) In regard to the double patenting rejection, Applicant alleges that the cited patent does not render the presently claimed invention obvious to one of skill in the art.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention discloses a composite compound of mineral or organic fillers or pigments blended with binding agent as does the patent.

Conclusion

14) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 571-272-1190. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Halpern
Primary Examiner
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